

REMARKS/ARGUMENTS

Applicant appreciates the Examiner's continued thorough search and examination of the present patent application.

Claims 1, 3-4, 6, 10 and 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar et al. ("Oscar," U.S. Patent Application Publication No. 2001/0037216) in view of Ullman ("Ullman," U.S. Patent Application Publication No. 2002/0002495) and further in view of Freeman, Jr., et al. ("Freeman," U.S. Patent Application No. 6,012,035). Applicant respectfully traverses this rejection.

Applicant respectfully submits that elements defined in claim 1 are not taught, suggested or disclosed by either Oscar, Ullman and Freeman, nor does the combination of those references teach, suggest or disclose the missing elements of applicant's claim 1. Since elements of applicant's claim 1 are missing from each of Oscar, Ullman and Freeman, the combination of those references cannot render the claims obvious under 35 U.S.C. §103(a).

The missing elements in applicant's claim 1 include "b) designing [a] prescription benefits plan", "e) enrolling each eligible subscriber who wishes to participate in the prescription benefits plan," "h) iii) [charging a] subscriber's credit account for accepted claims, the amount of the charge being equal to the price of the prescription minus a predetermined co-payment which is tendered by the subscriber to the pharmacy at the time of fulfilling the prescription." Furthermore, the missing elements include "i) a first payment, made by the creditor to the prescription benefits manager" that is "equal to the amount charged to the subscriber's account minus a first predetermined service fee to be retained by the creditor," "j) a second payment, made by the prescription benefits manager to the pharmacy" that is "equal to a predetermined portion of the prescription price," and a "k) third payment made by the prescription benefits manager to the claims processor" that is "equal to a predetermined service fee." Applicant addresses the Examiner's rejection of claim 1 in connection with each of Oscar, Ullman and Freeman, respectively.

In the present Office Action, the Examiner cites to Oscar, paragraphs [0063]-[0064] for teaching applicant's claimed step of "designing the prescription benefits plan." Applicant respectfully disagrees with the Examiner. Oscar teaches a consultant module 120 that is usable for analyzing and constructing a benefits plan, i.e., by proposing modifications to an existing

plan, but is not usable for “designing” a plan. Instead, Oscar teaches that consultants are “permitted” to “select a particular pharmacy benefits plan” to display “drug utilization” of the selected plan by “drug class” (see Oscar, paragraph [0063]). Consultants review statistics regarding “total payment” by the selected plan, the “percentage of plan payment for [a drug] class as compared to total expenditures,” “total out of pocket payment for recipients for [the selected drug class]” and “percentage of out of pocket payment for [the selected] drug class as compared to total recipient out of pocket payment under the [selected] plan.” Thus, by making selections within a “particular pharmacy benefits plan,” cost benefits can be compared.

Applicant submits that Oscar does not teach or suggest applicant’s claim 1 feature of “designing” a prescription benefits plan. As described in applicant’s written specification, the designing includes,

“... defining what medical products and prescription medications are covered, what portion of the cost the patient is responsible for, the amount of co-payment to be tendered by the patient at the time of dispensing, and what portion of the cost of the products and prescriptions the pharmacy is responsible for. The plan design also preferably includes a formulary of preferred medications”

(see applicant’s specification, paragraph [0016]).

Applicant submits, therefore, that Oscar’s feature of enabling consultants to propose modifications to an existing benefits plan based on statistical analysis is patentably distinct from applicant’s claimed step of “designing a prescription benefits plan.” Consultants in Oscar are not entitled to define what medical products and prescription medications are covered, what portion of the cost the patient is responsible for, the amount of co-payment to be tendered by the patient at the time of dispensing, and what portion of the cost of the products and prescriptions the pharmacy is responsible for. Consultants, instead, can only propose modifications to an existing plan.

Moreover, applicant disagrees with the Examiner’s characterization that Oscar teaches applicant’s claimed step of “enrolling” a subscriber into “the prescription benefits plan.” Instead, Oscar merely registers users to interface with the management server 110. The registration process of paragraph [0050], cited by the Examiner, includes receiving from the recipient a selection representing the recipient’s “plan sponsor from [a] list of search results, to determine which benefits plan the recipient is subject to” (Oscar, paragraph [0049]). Therefore, no

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enrollment into a prescription benefits plan that is designed by Oscar is taught, disclosed or suggested.

The remaining missing elements are also not taught, suggested or disclosed by Oscar. In particular, Oscar does not teach or suggest “[charging a] subscriber’s credit account for accepted claims, the amount of the charge being equal to the price of the prescription minus a predetermined co-payment which is tendered by the subscriber to the pharmacy at the time of fulfilling the prescription.” Further, Oscar does not teach or suggest “a first payment, made by the creditor to the prescription benefits manager” that is “equal to the amount charged to the subscriber’s account minus a first predetermined service fee to be retained by the creditor.” Further, Oscar does not teach or suggest “a second payment, made by the prescription benefits manager to the pharmacy” that is “equal to a predetermined portion of the prescription price,” a “third payment made by the prescription benefits manager to the claims processor” that is “equal to a predetermined service fee.”

Ullman, similarly, does not supply the missing elements. Ullman is cited for teaching applicant’s claimed steps d), g), h), i), j) and k).

Ullman utilizes a standard electronic message format set by the National Council for Prescription Drug Programs (“NCPDP”), and adopts the “switch for an integrated system of instant adjudication, consumer data warehousing and incentive rewards for [a] consumer” (see paragraph [0023]). Unlike applicant’s claim 1, Ullman teaches that information regarding a “prescription, the patient, and his insurance, discount or savings coverage” is input into a computer, and transmitted to appropriate “obligors or processors” (paragraph [0024]). Unlike applicant’s claim 1, Ullman does not teach or suggest “designing” or “enrolling” subscribers in a prescription benefits plan.

Moreover, Ullman does not teach, suggest or disclose applicant’s claimed feature of “a first payment, made by the creditor to the prescription benefits manager” that is “equal to the amount charged to the subscriber’s account minus a first predetermined service fee to be retained by the creditor.” Further, Ullman does not teach or suggest “a second payment, made by the prescription benefits manager to the pharmacy” that is “equal to a predetermined portion of the prescription price,” a “third payment made by the prescription benefits manager to the claims processor” that is “equal to a predetermined service fee.” Applicant has reviewed the cited

portions of Ullman, namely paragraphs [0031], [0032], [0017] and [0012], and disagrees with the Examiner that these passages, or Ullman, more generally, teach, suggest or disclose the missing features.

Freeman also does not teach or suggest the missing elements of applicant's claim 1. Freeman is cited for teaching applicant's claimed feature of "a first payment, made by the creditor to the prescription benefits manager" that is "equal to the amount charged to the subscriber's account minus a first predetermined service fee to be retained by the creditor." While Freeman mentions that a financial institution retains a "transaction fee used to pay for the bank's services," Freeman is silent with respect to the payment being made to a prescription benefits manager.

Further, Freeman is silent with respect to the remaining missing elements. In particular, Freeman does not teach or suggest "designing" a prescription benefits plan and "enrolling" subscribers in the prescription benefits plan. Freeman also does not teach or suggest applicant's claimed step of "establishing a prescription benefits manager to administer the prescription benefits plan." Freeman also does not teach or suggest "a second payment, made by the prescription benefits manager to the pharmacy" that is "equal to a predetermined portion of the prescription price," and a "third payment made by the prescription benefits manager to the claims processor" that is "equal to a predetermined service fee."

Therefore, and for the foregoing reasons, applicant respectfully submits that even if one were to combine Oscar, Ullman and Freeman, as the Examiner has done (arguably using hindsight in view of applicant's disclosure and claimed invention), applicant's claim 1 still would not be taught because the missing elements are not taught, disclosed or suggested. Therefore, claim 1 is not obvious under 35 U.S.C. §103(a) over Oscar, Ullman and Freeman, and reconsideration is respectfully requested.

Claims 3-4, 6, 10 and 12-14 depend directly or indirectly from claim 1 and are, therefore, patentable for the same reasons as well as because of the combination of elements in those claims with the features set forth in the claim(s) from which they depend.

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar in view of Ullman and further in view of Freeman and Judge ("Judge," U.S. Patent Application Publication No. 2002/0111832). Applicant respectfully traverses this rejection.

Judge is cited for teaching performing a drug regimen review prior to approving a claim, and advising a pharmacy of the review results. Applicant respectfully submits, however, that Judge does not teach or suggest the missing elements. Judge, instead, is directed to delivering a pharmaceutical prescription copay counselor over an internet protocol network. As described above with reference to Oscar, Ullman and Freeman, Judge does not teach or suggest applicant's missing elements, including "designing" or "enrolling" subscribers in a prescription benefits plan. Judge also does not teach or suggest to applicant's claimed step of "establishing a prescription benefits manager to administer the prescription benefits plan." Judge also does not teach or suggest "a first payment, made by the creditor to the prescription benefits manager" that is "equal to the amount charged to the subscriber's account minus a first predetermined service fee to be retained by the creditor." Further, Judge does not teach or suggest "a second payment, made by the prescription benefits manager to the pharmacy" that is "equal to a predetermined portion of the prescription price," a "third payment made by the prescription benefits manager to the claims processor" that is "equal to a predetermined service fee." Judge's tool, instead, "enables consumers and physicians, and others involved with prescription drug benefits, to identify lower cost and copay alternatives that are available within a third-party paid benefit" (see paragraph [0008]). Accordingly, applicant respectfully submits that the addition of Judge with Oscar, Ullman and Freeman does render applicant's claim 2, which depends directly from claim 1, obvious under 35 U.S.C. §103(a). Reconsideration is respectfully requested.

Claims 5, 7-9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar in view of Ullman and further in view of Freeman and Mayaud ("Mayaud," U.S. Patent No. 5,845,255). Applicant traverses this rejection.

Mayaud is cited for teaching adjudicating a claim by checking a prescription against a formulary and recommending medications to the pharmacy for fulfilling the prescription. Applicant respectfully submits that Mayaud does not teach or suggest the missing elements that are missing from the combined teachings of Oscar, Ullman and Freeman. Mayaud is directed to a clinical prescription management system for improving the quality of prescriptions that are written by physicians (see column 4, lines 21-26). Unlike applicant's, claim 1, Mayaud does not regard a method of providing prescription benefits to subscribers under a plan, and, as described above with reference to Oscar, Ullman and Freeman, Mayaud does not teach or suggest the

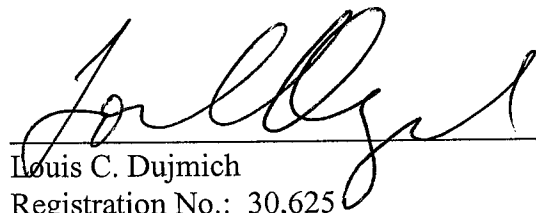
missing elements.

Therefore, claims 5, 7-9 and 11, which depend directly or indirectly from claim 1, are patentable as well as because of the combination of features in those claims with the features set forth in the claim(s) from which they depend.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this application to issue.

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Louis C. Dujmich", is written over a horizontal line.

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